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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,620	01/31/2005	Eiji Terada	264732US0PCT	6922
22850	7590	07/02/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DELCOTTO, GREGORY R	
			ART UNIT 1751	PAPER NUMBER
			NOTIFICATION DATE 07/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/522,620	Applicant(s) TERADA, EIJI	
	Examiner Gregory R. Del Cotto	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-7 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to instant claim 4, it is vague and indefinite in that it is not clear what is meant by sulfate-, sulfonate-, carboxylate- "type" surfactants. The specification provides no definition or guidance as to what is meant by the word "type" and in the absence of such a definition or guidance, it would not be clear to one of ordinary skill in the art as to what compounds other than those specifically listed would fall within the scope of "type" as recited by instant claim 4. Thus, one of ordinary skill in the art would not be able to determine the metes and bounds of the claimed invention. Note the, the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955). See MPEP 2173.05(b).

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by WO03/066007.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

'007 teaches a hair care composition which comprises an amino, polyol functional siloxane material, wherein the amino, polyol functional siloxane material may be prepared by reacting certain amino functional siloxane with one or more monoepoxides. Preferred hair care compositions include a shampoo composition, a leave-on conditioner, a semi-permanent colorant or a permanent colorant composition. Hair care compositions according to the invention are found to provide such benefits as improved conditioning, improved feel of the hair, reduction in colour fading and improved wash resistance of colour, depending on the type of composition provided. See Abstract. The specific siloxanes impart more than usual benefits of conditioning and improved feel to the hair. See para. 19. Note that, the silicone derivatives taught by '007 are the same as recited by the instant claims. See para. 6. The compositions

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further comprise at least one anionic deterative surfactant, with preferably also a foam boosting agent, a pH adjusting agent, a thickening agent, and water. The shampoo composition may be, for example, optically clear, opaque or pearlescent. See para. 20. Suitable anionic surfactants include alkali metal sulfates, ether sulfates, etc. See para. 21. A pH adjusting agent, preferably to adjust the pH within the range of 4 to 9, may also be used in the shampoo compositions. Suitable acidic pH adjusting agents include lactic acid, succinic acid, adipic acid, etc. See para. 25. Other optional components may be added to the compositions including polyols such as glycerine and propylene glycol, etc. See para. 28. '007 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '007 anticipate the material limitations of the instant claims.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurer et al (US 5,855,625) in view of Evans et al (US 6,171,515).

Maurer et al teach a laundry detergent for washing fabrics composed of proteinogenic fibers which contains at least one surfactant and a proteolytically active amount of a protease having a keratinase, caseinase activity ratio of less than about 0.80. See Abstract. The surfactants can be nonionic or anionic surfactants. Suitable anionic surfactants include the alkyl and alkenyl sulfates, ether sulfates, etc. See column 4, line 15 to column 5, line 65. To adjust an optionally acidic or mildly alkaline pH value of, in particular, about 8 to 9.5, the detergents may contain inorganic and/or organic acids or acidic salts such as succinic acid, adipic acid, or glutaric acid. See

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column 8, lines 25-40. Besides water, solvents which are used in particular in liquid detergents include ethanol, propanol, isopropanol, ethylene glycol, etc. See column 8, lines 60-69.

Maurer et al do not teach the use of the specific silicone derivative or a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Evans et al teach a fiber treatment composition which contains siloxanes having amine- and polyol- functionalities. The composition provides good hand, resistance to yellowing, and hydrophilicity to the fibers. The composition is preferably formulated as an aqueous emulsion. See Abstract and column 3, lines 10-20. Note that, the siloxane as taught by Evans et al is the same as the silicone derivative as recited by the instant claims. See column 3, lines 20-69. The textile treatment composition can have any suitable form. For example, the composition can be applied to the textile neat. However, the textile treatment composition can be a solution, dispersion, or emulsion. See column 6, lines 35-45. The fiber treatment composition can be applied to the fibers during the making of the fibers or later, such as during laundering the fabric. The textiles that can be treated with the textile treatment composition include natural fibers such as cotton, silk, linen, and wool; regenerated fibers such as rayon and acetate, synthetic fibers such as polyesters, polyamides, polyacrylonitriles, polyethylenes, etc. See column 7, lines 35-69.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a specific silicone derivative in the composition taught by Maurer et al, with a reasonable expectation of success, because Evans et al teach that the use of the specific silicone derivative in a similar composition used to launder or treat fabrics provides good hand, resistance to yellowing, and hydrophilicity to the textile fibers which would be desirable in the cleaning compositions taught by Maurer et al.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Maurer et al in combination with Evans et al suggests a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Man (US 6,506,261) in view of Evans et al (US 6,171,515).

Man teaches cleaning compositions containing nonionic surfactants, silicone surfactants, anionic surfactants, hydrotropes, and other optional functional materials including sequestrants. Substrates such as laundry and heavily soiled hard surfaces containing a substantial proportion of organic/inorganic soils such as greases, oils, and other hard to remove soil materials are readily cleaned by the compositions. See

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Abstract. Suitable anionic surfactants include sulfonate, sulfate, and phosphate materials. See column 11, lines 10-20. Hydrotropes or couplers may be used in the compositions and include ethanol, isopropanol, n-propanol, etc. See column 12, lines 40-60.

Acidulants or alkaline agents are used to maintain the appropriate pH for the cleaners of the invention. Suitable acidulants include lactic acid, adipic acid, succinic acid, maleic acid, etc. In general, the pH of the compositions can vary from a low of about 2 to a maximum of about 13.0. See column 13, lines 1-40.

Man does not teach the use of the specific silicone derivative or a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Evans et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a specific silicone derivative in the composition taught by Man, with a reasonable expectation of success, because Evans et al teach that the use of the specific silicone derivative in a similar composition used to launder or treat fabrics provides provides good hand, resistance to yellowing, and hydrophilicity to the textile fibers which would be desirable in the cleaning compositions taught by Man.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the

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composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Man in combination with Evans et al suggests a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshowski et al (US 5,137,715) in view of WO03/066007.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Hoshowski et al teach a hair shampoo-conditioner composition including an anionic cleansing surfactant such as an alkyl sulfate or an alkyl ether sulfate and a polymeric conditioning agent in a suitable carrier, and having a pH of from about 2.5 to less than 7, to cleanse the hair. See Abstract. An acid is used to neutralize the amido amine compound which makes up the polymeric conditioning agent and to adjust the final pH of the composition to within a range of 2.5 to 7. Suitable acids include citric acid, lactic acid, gluconic acid, etc. See column 13, lines 40-65. The carrier is predominantly water but may contain solvents such as glycerol, ethylene glycol, etc. See column 16, lines 1-26.

Hoshowski et al do not teach the use of the specific silicone derivative or a composition containing an anionic surfactant, a carboxylic acid, a specific silicone

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derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

'007 is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific silicone derivative in the composition taught by Hoshowski et al, with a reasonable expectation of success, because '007 that the specific silicone derivatives impart more than the usual benefits of conditioning and improved feel to the hair in a similar cleaning composition.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Hoshowski et al in combination with '007 suggests a composition containing an anionic surfactant, a carboxylic acid, a specific silicone derivative, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

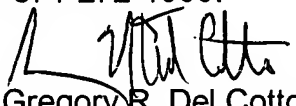
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Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gregory R. Del Cotto
Primary Examiner
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